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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. |
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08/943,511 10/06/97 DIAB

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STEPHEN C JENSEN
KNOBBE MARTENS OLSON AND BEAR
SIXTEENTH FLOOR
620 NEWPORT CENTER DRIVE
NEWPORT BEACH CA 92660

EXAMINER

WINAKUR, E

ART UNIT

PAPER NUMBER

3736

DATE MAILED:

06/06/00

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Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

| | | | |
|------------------------------|--------------------------------------|------------------------------------|--|
| Office Action Summary | Application No. 08/943,511 | Applicant(s) DIAB ET AL. | |
| | Examiner Eric F Winakur | Art Unit 3736 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

Status

- 1) ☒ Responsive to communication(s) filed on 20 March 2000.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 39-47, 51-55 and 62-78 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 45-47 and 72-78 is/are allowed.
- 6) ☒ Claim(s) 39-44, 51-55 and 62-71 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- a) ☐ All b) ☐ Some * c) ☐ None of the CERTIFIED copies of the priority documents have been:
1. ☐ received.
2. ☐ received in Application No. (Series Code / Serial Number) _____.
3. ☐ received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. & 119(e).

Attachment(s)

- 15) ☐ Notice of References Cited (PTO-892)
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 17) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 11.
- 18) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 19) ☐ Notice of Informal Patent Application (PTO-152)
- 20) ☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
2. Claims 39 - 44, 51 - 55, and 62 - 71 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. With regard to claim 39, it appears that the term "and" should be inserted at the end of line 7; Applicant is requested to confirm that the bracket of the form '{' in line 11 prior to the word "tracks" is a typo that should have been a bracket of the form '['. With regard to claim 42, it appears that the phrase "each of" should be inserted before "said" (line 3); it appears that the phrase "generate an approximation" should read "generating approximations" and the phrase "selecting a resulting arterial oxygen saturation" should read "selecting a resulting arterial oxygen saturation from said approximations" to clearly set forth from what the selection is done. With regard to claim 51, the term "Kalman" should be inserted before "filter" (line 8). With regard to claim 53, it appears that the term "parameters" should read parameter. With regard to claim 62, it appears that the term "signal" (line 2) should read "signals"; it appears that the term "Calculating" (line 9) should read "calculating". With regard to claims 67 and 68, a period must be placed at the end of the claim. With regard to claim 68, it appears that the phrase "the intensity signal" should read "each of the intensity signals".

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Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 39 - 41 and 66 - 70 are rejected under 35 U.S.C. 102(b) as being anticipated by Frick et al. (USPN 4,824,242 - cited by Applicant). Frick et al. teach a pulse oximeter system that includes LEDs emitting two wavelengths, a detector, and processing elements for receiving detector signals, calculating a ratio, and determining the oxygen saturation from the ratio. It is inherent that the signals recorded by the detector would include a first portion related to attenuation and a second portion, during motion, related to motion induced noise. It is further inherent that when processing the signals during motion, the resulting values would be an "approximation" of the oxygen saturation, as set forth in the claims, as there would be some error due to the noise signal. It is noted that the recitation with regard to the processor set forth in claim 72 is not met by Frick et al.

Allowable Subject Matter

5. Claims 42 - 44, 51 - 55, 62 - 65, and 71 would be allowable if rewritten or amended to overcome the rejection(s) under 35 U.S.C. 112, second paragraph, set forth in this Office action.

6. Claims 45 - 47 and 72 - 78 are allowed.

Conclusion

7. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Eric F Winakur whose telephone number is (703) 308-3940. The examiner can normally be reached on Mon. - Thurs. from 7:30 am - 5:00 pm and on alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Cary O'Connor can be reached on (703) 308-2701. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 308-0758 for regular communications and (703) 308-0758 for After Final communications.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0858.

A handwritten signature in black ink, appearing to read 'E. Winakur', is positioned above the printed name.

Eric F Winakur
Primary Examiner
Art Unit 3736

June 5, 2000